

to the Office Action.

1. Withdrawal Of Claims 1-17

At section 1 of the Office Action, claims 1-17 were withdrawn from further consideration. The *Office Action Summary* indicates claims 1-27 were withdrawn from consideration. Clarification is requested as to whether claims 18-27 are withdrawn.

2. Rejection Of Claims 28-33, 35 and 38-40

At section 4 of the Office Action, claims 28-33, 35 and 38-40 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,602,637 (Elmqvist et al.) and U.S. Pat. No. 4,679,572 (Baker, Jr.). In the Office Action, it was acknowledged that Elmqvist et al. does not disclose or suggest combining the first layer with an iridium surface layer. Baker, Jr. is cited in the Office Action as disclosing an electrode with an iridium surface layer.

It was argued in the Office Action that one having ordinary skill in the art at the time of the invention would have found it obvious to combine the teachings of Elmqvist et al. and Baker, Jr. because doing so would have resulted in obtaining lower polarization, thereby making available more energy for tissue stimulation. It is respectfully submitted that the technology disclosed in Elmqvist et al. and the technology disclosed in Baker, Jr. have been publicly known for over 15 years. Despite the advantages relied on in the Office Action to support combining Elmqvist et al. and Baker, Jr., there has not been an electrode like the one claimed in claim 28 until it was invented by Messrs. Gelb and Platt. If the electrode of claim 28 were as obvious as was argued in the Office Action, then given the large amount of research that is done on electrodes, the importance of electrodes to the medical community, and the benefits of electrodes to many people, certainly one of the many researchers in the field of electrodes would have discovered the electrode described in claim 28 long before it was invented by Messrs. Gelb and

Platt. Since there is no evidence that such an electrode was ever made or suggested, it is inappropriate to argue otherwise.

The rejection of claims 28-33, 35 and 38-40 strongly suggests hindsight reconstruction, which is impermissible. It is impermissible to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. When a rejection depends on a combination of prior art references (as is the situation here), there must be some teaching, suggestion, or motivation to combine the references. Combining prior art references without evidence of a suggestion, teaching, or motivation impermissibly takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. See Ecolchem Inc. v. Southern California Edison Co., 56 U.S.P.Q.2d 1065 (CAFC 2000).

A proper application of the requirement for a showing of a teaching or motivation to combine the prior art references is lacking in this matter. There is no suggestion that an electrode made according to Elmqvist et al. should be coated with a layer that includes iridium. Nor does Baker, Jr. suggest that an electrode made according to Baker, Jr. would benefit from having a first layer that includes a material selected from the group of carbide, nitride or carbonitride of a least one of the metals, titanium, vanadium, zirconium, niobium, molybdenum, hafnium, tantalum or tungsten. It is only by having reviewed the patent application of Messrs. Gelb and Platt that one may now realize that benefits may be achieved by making an electrode according to claim 28. Consequently, arguing that Elmqvist et al. should be combined with Baker, Jr. appears to be nothing more than hindsight reconstruction, and therefore, the rejection must be withdrawn.

Claims 29-33, 35 and 38-40 depend from claim 28, and as such, claims 29-33, 35 and 38-40 have all the limitations of claim 28. Consequently, the arguments set forth above in support of claim 28 are equally applicable to claims 29-33, 35 and 38-40.

In addition, it is respectfully submitted that Elmqvist et al. in view of Baker, Jr. does not render the specific method of claims 36 or 37 obvious. It is requested that the rejection of claims

36 and 37 be reconsidered in view of the fact that neither Elmqvist et al. nor Baker, Jr. suggest (a) DC sputtering in a nitrogen rich atmosphere while an RF bias is applied to the substrate or (b) DC sputtering in a nitrogen rich atmosphere for a period of time while an RF bias is applied to the electrode, and then for a period of time while no RF bias is applied to the electrode.

For the reasons set forth above, it is respectfully requested that the rejection of claims 28-33, 35 and 38-40 be withdrawn.

3. Rejection Of Claims 34, 36 and 37

At section 5 of the Office Action, claims 34, 36 and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,602,637 (Elmqvist et al.) and U.S. Pat. No. 4,679,572 (Baker, Jr.), as applied in section 4 of the office action, and further in view of U.S. Pat. No. 4,584,079 (Lee et al.). It is respectfully submitted that claims 34, 36 and 37 depend from claim 28, and as such, claims 34, 36 and 37 have all the limitations of claim 28.

Consequently, the arguments set forth above in support of claim 28 are equally applicable to claims 34, 36 and 37. Lee et al. fails to make up for the deficiencies of Elmqvist et al. and Baker, Jr. As such, the rejection of claims 34, 36 and 37 must be withdrawn.

There are additional reasons that the rejection of claims 34, 36 and 37 should be withdrawn. In the Office Action, it was argued that Lee et al. discloses application of an RF bias to the substrate to lessen the cusping that occurs during manufacture and thereby improve the planarization in a multi-layer structure. Whether or not this is true, Lee et al. does not disclose or suggest applying an RF bias to the substrate while DC sputtering. Instead, Lee et al. discloses use of an RF bias with RF sputtering. There is no suggestion in Lee et al. that an RF bias should be used in a DC sputtering situation. Nor does Lee et al. suggest that DC sputtering should occur for a period of time while an RF bias is applied to the electrode, and then for a period of time while no RF bias is applied to the electrode. For these additional reasons, claims 34, 36 and 37 should be allowed.

Conclusion

It is respectfully submitted a full and complete response to the Office Action has been made. The claims are in condition for allowance. Allowance of the claims is respectfully requested. The Examiner is invited to call applicants' attorney if any questions remain following review of this response.

Date: November 1, 2002

Respectfully submitted,



R. Kent Roberts  
Attorney for Applicants  
Registration No. 40,786

Hodgson Russ LLP  
One M&T Plaza, Suite 2000  
Buffalo, NY 14203-2391